



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/523,273

01/31/2005

Dennis M Klinman

4239-66339-03

2295

36218 7590 05/29/2008

KLARQUIST SPARKMAN, LLP
121 S.W. SALMON STREET
SUITE #1600
PORTLAND, OR 97204-2988

EXAMINER

HORNING, MICHELLE S

ART UNIT

PAPER NUMBER

1648

MAIL DATE

DELIVERY MODE

05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

This office action is responsive to communication filed 2/15/2008. The status of the claims is as follows: claims 24, 25, 34, 37, 38, 40-43 and 51-53 are under current examination.

The following are withdrawn due to amendments to the specification and the filing of the terminal disclaimer:

1. Objection to the Specification; and
2. Double Patenting.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24, 25, 34, 37, 38, 40-43 and 51-53 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for inflammatory arthritis, does not reasonably provide enablement for any and all inflammatory arthropathies. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Enablement is considered in view of the *Wands* factors. Please note that the arguments provided by Applicants were considered and found to be partially persuasive. More specifically, Applicants provided an adequate showing based upon both the literature and the instant specification that the animal models used

are accepted models for inflammatory arthritis. The arguments, however, fail to address the breadth of the claims which are drawn to inflammatory arthropathy.

Nature of the Invention. The claims are drawn to a method of suppressing an immune response in a subject with inflammatory arthropathy.

Breadth of the claims. As mentioned in the previous office action, the claims are extremely broad encompassing all inflammatory joint diseases. Such diseases may include ankylosing spondylitis, Sjogren's syndrome and lupus.

Guidance in the specification. The specification provides support only for arthritis.

Working examples. Examples of art accepted animal models for arthritis and suppression of an immune response by ODNs are provided. The examples do not cover all inflammatory joint diseases.

Predictability of the art. There is no way the ordinary artisan could predict the effects of a suppressive ODN for all inflammatory joint diseases. The specification fails to provide a common mechanism in all inflammatory joint diseases in which the specific ODN would demonstrate a suppression of an immune response. Further, the prior art does not teach that the disclosed animal models are accepted for all possible inflammatory joint diseases.

Amount of experimentation necessary. Much experimentation is necessary, including providing proper models for all inflammatory joint diseases, ascertaining a common mechanism among them and demonstrating that the specific ODN would lead to a suppression of an immune response.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE HORNING whose telephone number is (571)272-9036. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1648

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle Horning/
Examiner, Art Unit 1648

/Bruce Campell/
Supervisory Patent Examiner, Art Unit 1648